

### **REMARKS**

Claims 1-20 and 22-33 are pending in the current application. Applicants note that the Office Action Summary mistakenly states claims 1-33 are pending, when in fact claim 21 has been cancelled. Applicants have amended claims 12, 19, 24, and 32, particularly noting that claim 19 was amended for purposes of consistency in the terminology employed. Reexamination and reconsideration of all of the claims are respectfully requested.

#### **§ 102(b)**

The Examiner rejected claims 12-14, 16, 18, 20, 22, 24, 27, and 31 under 35 U.S.C. § 102(b) based on Vaught et al., U.S. Patent 5,264,912. The Examiner further rejected claim 32 under 35 U.S.C. § 102(e) based on Bishop, U.S. Patent 6,091,488 (“Bishop”).<sup>1</sup>

Applicants have amended claims 12 and 24 to include the aspect of an offset fly lens in the claimed multiple element offset fly lens arrangement (claim 12) and the multiple element passing means comprising an offset fly lens arrangement (claim 24). Vaught shows no such multiple element offset fly lens arrangement or offset fly lens arrangement. Applicants submit that claims 12 and 24, as amended, are not anticipated by Vaught, and that the claims dependent therefrom, namely claims 16, 18, 20, 22, 27, and 31, are also not anticipated by Vaught.

Applicants have amended claim 32 to include the aspect of an offset fly lens in the claimed multiple element offset fly lens arrangement. Bishop shows no such multiple element offset fly lens arrangement. Applicants submit that claim 32, as amended, is not anticipated by Bishop.

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<sup>1</sup> Applicants note that the Bishop application was filed on March 22, 1999, *one day* before the filing of the present application. While Applicants submit that the amendments and arguments included herein serve to differentiate the present claims 1-20 and 22-33 from all cited references, Applicants additionally believe that demonstrating invention via conception prior to March 22, 1999 and diligent reduction to practice from just prior to March 22, 1999 until March 23, 1999, may be available, thereby completely removing the Bishop reference in particular from consideration.

**§ 103**

The Examiner further rejected claims 1, 2, 4-12, 15, 17, 19, 24-26, 28-30, 32, and 33 under 35 U.S.C. § 103(a) based on Kerstens (U.S. Patent 5,248,876) in view of Bishop.

The Office Action recognizes that the concept of a time delay and integration charged couple device (TDI CCD) is missing from Kerstens, and finds that aspect of the invention in Bishop. Kerstens in fact shows a sensor array 296 that has no TDI or CCD characteristics available. Bishop does not include a fly lens arrangement or other multiple element arrangement employing a fly lens arrangement as presently claimed by Applicants in independent claims 1, 12, 24, and 32, as amended.

Applicants contend that no motivation to combine the references in the manner suggested is presented within the references themselves. The sole statement in the Office Action in this regard is “it would have been obvious to one of ordinary skill in the art to provide a time delay and integration charge coupled device in the device of Kerstens as such devices are well known in the art as shown by Bishop, in order to enable scanning at high speeds without obtaining blur”. This statement does not demonstrate a motivation to combine explicit or implied within the references themselves, but instead recites a desired result, namely the claims provided by Applicants, and the advantages provided by the claimed element, namely the advantages in using the TDI CCD sensor as claimed by Applicants. Applicants contend that in reality, no motivation to employ a CCD or TDI sensor such as is shown in the Bishop design is included in Kerstens, and certainly no motivation to employ the design of Kerstens is included in Bishop.

The Federal Circuit has held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Without some showing in the prior art that suggests in some way a combination in order to arrive at the claimed invention, it is impermissible to use the Applicant’s teaching to search references for the claimed elements and combine them as claimed. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also, Ex Parte Lange*, 72 U.S.P.Q. 90,

91 (C.C.P.A. 1947) (“It seems to us that the Examiner is using appellant’s disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by Applicant.”); *In re Leonor*, 158 U.S.P.Q. 20, 21 (C.C.P.A. 1968) (the issue is “whether teachings of prior art would, of themselves, and without benefit of applicant’s disclosure, suggest [a process] which would make claimed invention obvious...””) (emphasis in original). As noted, the Kerstens reference does not suggest combining the design disclosed with the TDI CCD camera of Bishop to produce the unique system claimed in Applicants’ independent claims.

Applicants respectfully submit that the Examiner has used hindsight in rejecting the claims herein. It is only through hindsight, after seeing Applicants’ disclosure, that it would be considered possible to create the system and method for inspecting a specimen as claimed by the Applicants.

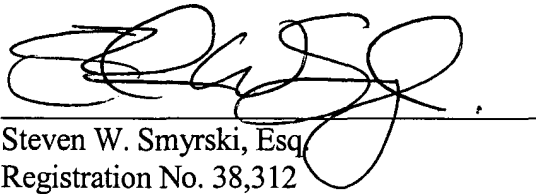
With regard to the use of hindsight, or the use of an Applicant’s teaching to combine references, the courts have overwhelmingly condemned such combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), (condemning the “insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”); *In re Fine*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”) Applicants respectfully submit that combination of aspects of the Kerstens reference with the Bishop design is merely a hindsight reconstruction of the invention using Applicants’ disclosure and claims as a guide. Such hindsight reconstruction of the claimed system is inappropriate and thus rejection of the independent claims 1, 12, 24, and 32 for this reason is improper. Applicants thus respectfully submit that claims 1, 12, 24, and 32 are allowable over the references of record, and that all claims dependent from these allowable independent claims are allowable as they depend from an allowable base claim. Accordingly, it is respectfully submitted that all claims fully comply with 35 U.S.C. §103.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

Should it be determined for any reason an insufficient fee has been paid, please charge any insufficiency to ensure consideration and allowance of this application to Deposit Account 502026.

Respectfully submitted,



Steven W. Smyrski, Esq.  
Registration No. 38,312

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SMYRSKI & LIVESAY, LLP  
3310 Airport Avenue, SW  
Santa Monica, California 90405-6118  
Phone: 310.397.9118  
Fax: 310.397.9158

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS**

Claim 12 has been amended as follows:

12. (Amended) A specimen inspection system, comprising:  
a light energy source;  
a multiple element offset fly lens arrangement for receiving energy from said energy source and selectively passing the light energy received;  
a lensing arrangement for measuring and canceling topographical variations during inspection;  
a pinhole mask for filtering light energy received from said lensing arrangement; and  
a time delay and integration charge coupled device for receiving light energy from the pinhole mask.

Claim 19 has been amended as follows:

19. (Amended) The specimen inspection system of claim 15, wherein said fly lens [arrangement] array comprises a plurality of offset individual lenses.

Claim 24 has been amended as follows:

24. (Amended) A system for inspecting a semiconductor wafer specimen, comprising:  
illumination means for generating light energy;  
multiple element passing means for selectively filtering and passing energy received from said illumination means;  
lensing means for imparting light energy onto said semiconductor wafer specimen;  
masking means for further selectively filtering and passing energy received from said lensing means; and  
a time delay integration charge coupled device for receiving light energy from said masking means;

wherein said multiple element passing means comprises an offset fly lens arrangement.

Claim 32 has been amended as follows:

32. (Amended) A method for inspecting a specimen, comprising:  
generating light energy;  
selectively filtering and passing energy received from said light energy generating  
using a multiple element offset fly lens arrangement;  
imparting light energy from the multiple element arrangement onto said  
specimen;  
further selectively filtering and passing energy reflected from said specimen; and  
performing a time delay and integration sensing function on light energy received  
from said further selectively filtering and passing.